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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/757,877 | 01/14/2004 | Thomas P. Feist | 08CN8803-28 | 5188 |
| 23413 | 7590 | 11/07/2006 | EXAMINER | |
| CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002 | | | KIM, PAUL D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3729 | |
| DATE MAILED: 11/07/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|--------------------------------------|-------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/757,877 | Applicant(s) FEIST ET AL. | |
| | Examiner Paul D. Kim | Art Unit 3729 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

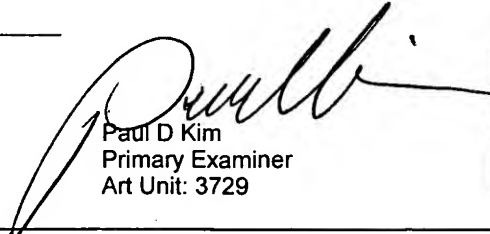
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 18-26.
 Claim(s) withdrawn from consideration: 1, 16, 17 and 27-30.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.


 Paul D. Kim
 Primary Examiner
 Art Unit: 3729

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the restriction requirement indicated by the examiner mailed on 8/28/2006 is not proper such that claim 27 further limits claim 18 by specifying the particular plastic used for the core and the plastic surface. Examiner traverses the argument that the original claimed invention as recited in claims 19 and 21 does not require in combination of the materials for the plastic surface made of thermoset and the perform core made of a material recited in claim 27. Also, applicant argues that claims 28-30 recited all of the element of claim 18. Examiner traverses the argument that claim 28 contains a recitation such as a process of disposing a thermoset coating on the reflective layer as recited in line 6, which does not recite in the originally presented invention, which the claim 18 does not require the process of disposing the thermoset coating on the reflective layer. Also, the reflective layer of claim 18 is disposed on the surface of the substrate, either one of the plastic surface or the core or both. However, the reflective layer of claim 28 is disposed on the surface features and the thermoset coating is disposed on the reflective layer. Therefore, the newly submitted claims 27-30 are directed to an invention that is independent or distinct from the invention originally claimed. Applicant also argues that the 112 rejections are not proper. Applicant argues that the plastic is in between the coating and the core. However, a thermoset coating is disposed on a side of the plastic surface opposite the core" as recited in lines 1-2 was not described in the specification as originally filed and appears to be new matter. It is also unclear as to what the side of the plastic surface opposite the core is indicated. The side of the plastic surface could be a predetermined place, such as a corner or edge, of the plastic surface or a whole or entire surface of the plastic surface opposite the core. Applicant also argues that the prior art of record fails to disclose the claimed invention such as a performed core. Examiner traverses the argument that Sandstrom teaches a process of injection molding a substrate formed from two or more layers bonded together. Therefore, one of the two or more layers can be a plastic having a plastic surface and another of the two or more layers can be a performed core. There is no structural definition what the perform core should be. Sandstrom also teaches that the materials for the two or more layers are thermoset, thermoplastic, metal or glass. Applicant also argues that the thickness of the disk is not obvious, because the obviousness is based upon what an artisan would be motivated to do with an expectation of success. Examiner traverses the argument. It is noted that the thickness between 0.6 mm to 2.5 mm for the recording medium is well known and commonly used for manufacturing the recording medium. However, Applicant has not disclosed that the specific thickness of the disk as recited in the claimed invention provides an advantage, is used for a particular purpose, or solves a stated problem. Even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art. More particularly, where the general conditions of claims are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In this instance applicant has failed to establish the specific thickness as claimed is critical and amount to more than a small numerical change from the prior art. Therefore, it would have been an obvious matter of design choice to modify the thickness of the disk of Sandstrom to obtain the claimed invention.